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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,632	04/02/2004	Kia Silverbrook	HYG003US	2082

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393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER

FRECH, KARL D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,632

Applicant(s)

SILVERBROOK ET AL.

Examiner

Karl D. Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-33,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,15-24,26-33,35 and 36 is/are rejected.
- 7) ☒ Claim(s) 14,25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's response filed 11/21/05 has been entered.
2. Claim 1 is objected to because of the following informalities: applicant suggest on page 11 of the response of 11/21/05 that claim 1 has been amended to recite "product item". Upon review, the claim as amended recites "productivity". However, the examiner has interpreted claim 1 to no recite "product item" as suggested by applicant's arguments. Appropriate correction is required.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,4-11,13,15-21,30-33,35,36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al 5,128,527.

Kawai discloses coded data to be disposed on a surface of a product, identifying the product. There are disclosed a plurality of coded data portions, including a UPC left block, UPC right block and add-on code. There is disclosed a sensing device, i.e. detector 10, for sensing at least one portion of the code and inherently the product identity distinguishing between products. The UPC itself identifies the product, i.e. second identifier indicative of the item. The add-on code identifies a family of products, i.e. class of products. Although not specifically stated in Kawai, the manufacture information is included in the data held in the UPC code. The add-on code is in the same code format as the traditional UPC code and thus is also interpreted as containing

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UPC coded information. The left block, right block and add-on of the UPC are interpreted as being sub-layouts. The sub-layouts taken together form the super-layout. The guard bars and center bar of the UPC are interpreted as target features, and are encoded specifically to indicate the relative position or orientation of the code. Kawai does not specifically disclose that the information in the code is a serial number, however, the actual information in the code does not further define the code structure and is interpreted as merely data. Each of the end bars and the guard bar are made of a plurality of features (individual bars and spaces) and thus at least 4 features are disclosed. The left end bar and the guard bar, or the right end bar and the guard bar indicated a plurality of layouts, i.e. left block and right block. The left end bar indicates the left region of the code; the right end bar indicates the right region of the code. The detector left and right end bars and guard bar are sensed and used to determine the orientation of the code. Thus the left and right end bars and guard bars and the left and right blocks define positions of the data elements within the layout.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 12,22-24,26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al 5,128,527. Kawai discloses that which is seen above. Kawai does not disclose the interleaved code. Official Notice is taken that interleaved codes are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to interleave the code of Kawai in order to provide a more "robust" code.

Kawai does not disclose the EPC. However, Official Notice is taken that the EPC code format is old and well known. It would have been obvious to a person of ordinary skill in the art to use the EPC format in Kawai in order to make the Kawai's invention easily implemented in Europe.

Kawai does not disclose the redundancy as claimed. Official Notice is also taken that redundancy in coded information is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide redundant information in the code of Kawai, thereby helping to ensure a readable code in the case where a portion of the code may be damaged.

Kawai does not disclose the invisible code or IR ink. Official notice is taken that bar codes printed in IR ink are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to print the code of Kawai in IR ink.

This would effectively obscure the code from the naked eye and thus would not visibly interfere with the surface of a product.

Kawai does not disclose that the code takes up at least 25% of the product surface.

Official notice is taken that codes printed on more than 25% of a surface of a product is known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to print the code on more than 25% of the product surface in order to maximize the amount of information held within the code.

8. Claims 14 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest to one of ordinary skill in the art at the time the invention, in conjunction with all the other claimed limitations, the tessellation as in claim 14, or the UPC encoded in a Reed-Solomon encoding as in claim 25.

10. Applicant's arguments filed 11/21/05 have been fully considered but they are not persuasive. Applicant argues that the UPC add on code does not identify the product item. The examiner agrees. However, this does not define the current invention over the prior art relied upon for rejection. The examiner points out that the main UPC code identifies the product item itself. Further, there is currently no limitation that the product item be the add on code or the main code, i.e. the examiner is free to interpret the product item identifier to be encoded in any portion of a bar code.

11. The examiner acknowledges that claims 30 and 33 were not previously explicitly recited in the previous rejection. Therefore, this rejection is not made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech
Primary Examiner
Art Unit 2876
